

18. (Original) A guide according to claim 17, wherein said first rod and second rod have high aspect ratios.

19. (Original) A guide according to claim 12, wherein said frame is transparent.

20. (Original) A guide according to claim 19, wherein said frame is made of acrylic.

21. (Currently Amended) The guide of claim 1 wherein said first rod and said second rod cross to form an angle ~~greater than~~ between 0 and ~~less than~~ 90 degrees.

22. (Currently Amended) The guide of claim 12 wherein said first rod and said second rod cross to form an angle ~~greater than~~ between 0 and ~~less than~~ 90 degrees.

23. (Previously Added) The guide of claim 1, where said first rod is attached to a first pair of grooves in said frame and said second rod is attached to a second pair of grooves in said frame.

24. (Previously Added) The guide of claim 12, where said first rod is attached to a first pair of grooves in said frame and said second rod is attached to a second pair of grooves in said frame.

REMARKS

I. Drawings

Applicant has submitted herewith a Request for Approval of Drawing Changes and a corrected Fig. 1, along with a redlined copy to indicate the changes. Changes made have been precisely those called out in Section 2 of the Office Action. Regarding the objection to the drawings contained in ¶ 3 of the Office Action, it has been rendered moot by the current amendments to claims 21 and 22. As currently amended, claims 21 and 22 recite that the first

rod and second rod cross to form an angle between zero and 90°. Figs. 1-3 show the first and second rods crossing at an indeterminate angle. Applicant submits that it is not necessary to depict the inventive concept by showing every possible angle between the claimed 0 and 90°. Therefore, Applicant believes that the drawing objection contained in ¶ 3 of the Office Action has been rendered moot and should be removed.

II. Claim Rejections

In the Office Action, claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nejad-Sattari* ("*Nejad-Sattari*") in view of *Schulte* et al. ("*Schulte*"). Applicant respectfully traverses this rejection and requests that it be withdrawn for the following reasons.

The Office Action takes the position that the device as claimed is substantially disclosed by *Nejad-Sattari* in Figs. 1 and 3, which show a frame with indicia releasably attached to a computer monitor. In fact, Figs. 1-2 show nothing of the kind. Fig. 3 depicts a computer monitor with the device of *Nejad-Sattari* positioned upon it. However, Applicant's reading of *Nejad-Sattari* in no way discloses "releasably attaching" or any other kind of attaching, of the *Nejad-Sattari* device to a computer monitor. Applicant submits that this is an element that has been supplied by the Office Action gratuitously and is not supported by the text. Moreover, the device in *Nejad-Sattari* is explicitly directed to determining scale in a captured image. Such device is not at all concerned with obtaining a two-dimensional position upon a computer monitor such that such a position can be correlated with anything, let alone a document, as is described in exemplary embodiments of the present invention. It is simply not understood why somebody seeking a device for allowing a user to keep their place on a computer screen would at all consult a method and apparatus for determining scale in photographic images. Scale

determination and two-dimensional place keeping on a computer monitor are simply functionalities or aims which have absolutely nothing in common.

Moreover, Applicant respectfully submits that there is no motivation in *Nejad-Sattari* to combine it with *Schulte* to obtain the claimed guide or any other device. *Schulte* is directed to an apparatus for mathematical geometric experimentation with variable straight lines, distances, angles and areas in one plane. *Schulte* is directed to an educational device for producing complex geometrical forms on a piece of paper. In no way is *Schulte* at all concerned with orienting a two-dimensional position by means of a first and a second rod, as is the device claimed in the present invention. In no way is *Schulte* concerned with scale in photographs. Moreover, in no way is *Schulte* concerned with computer monitors. Therefore, it is simply not understood by Applicant what the motivation to combine *Nejad-Sattari* with *Schulte* is, and where that would be found in either of the two references.

MPEP, at Section 706.02(j), states that to establish a *prima facie* case of obviousness there must be some suggestion in the references or in the knowledge generally available to one of ordinary skill in the art to combine reference teachings. Construing this exact issue, the Federal Circuit recently stated:

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), limited on other grounds by *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher).

Whether a motivation to combine prior art references has been demonstrated is a question of fact. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348, 53 USPQ2d 1580,

1586 (Fed. Cir. 2000). The assessment of whether to combine references in a given case has sometimes been viewed conceptually as a subset of the first Graham factor, the scope and content of the prior art. See, e.g., *id.*; *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881-83, 886, 45 USPQ2d 1977, 1981-82, 1985 (Fed. Cir. 1998). Although that view is not incorrect, accurate assessment of whether to combine references may require attention to other Graham factors. For example, the level of skill in the art may inform whether the artisan would find a suggestion to combine in the teachings of an exemplar of prior art. Where the level of skill is high, one may assume a keener appreciation of nuances taught by the prior art. Similarly, appreciation of the differences between the claims in suit and the scope of prior art references—a matter itself informed by the operative level of skill in the art—inform the question of whether to combine prior art references. At bottom, in each case the **factual inquiry whether to combine references must be thorough and searching.** (emphasis added)

McGinley v. Franklin Sports Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). Further amplifying this holding, the Federal Circuit added:

In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In re Lee, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Applicants submit that there is no motivation in either of *Nejad-Sattari* or *Schulte* to combine the two in any way, shape or form. *Nejad-Sattari* is directed to a scale determination device for photographs. While it describes using the described device with a digital photograph and depicts its device freely hanging in the center of a computer monitor display (assumably held there by a user), it has nothing at all to do with locating a precise point in two dimensions on a computer monitor by means of an attached two-rod device as claimed in the present invention.

Schulte is directed to an educational apparatus for drawing geometrical forms *on paper*. As well, it has nothing at all to do with locating a precise point in two dimensions on a computer monitor by means of a movably attached two-rod device as claimed in the present invention. It

has no rods whatsoever. It has threads! Further, it has nothing at all to do with the photographic scale determiner of *Nefad-Sattari* by any stretch of the imagination. Nobody, it is respectfully submitted, in either doing geometry homework or in trying to determine the relative scale of objects in a photograph would be motivated to use in any way the photographic scale finder of *Nefad-Sattari* with the geometric experimentation device of *Schulte*. Thus, there is simply no logical combination of these references for any imaginable purpose that Applicants can see, and no motivation for any such combination has been at all indicated by the Office Action.

Following the law of the Federal Circuit, the Examiner's rejection of independent claims 1-24 cannot be maintained. Thus, it is respectfully submitted that the Office Action has not complied with the recently refined Federal Circuit law adduced above by stating affirmatively what that alleged suggestion to combine these systems of disparate functionality and design is. There was no "result of a thorough and searching inquiry," and in no way was it particularly stated why someone trying to determine the actual scale of objects depicted in a photograph would attempt to somehow mix that with a geometric experimentation device and therein find a suggestion of some desirability (see requirement of MPEP 2143.01) for such a combination.

Even if there was some motivation for combining these disconnected references, such combination would still not teach all of the claimed elements of the guide of independent claims 1 or 12. Neither reference teaches a first or second rod movable attached to a mounted frame.

For at least the reasons cited above, the stated rejection of claims 1-24 is without basis, and is respectfully requested to be withdrawn.

No additional fees are believed due herewith. However, the Commissioner is hereby authorized to charge any fee(s) deemed necessary to Deposit Account No. 50-0540. Early and favorable action is earnestly solicited.

Respectfully submitted,

By: 

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